

U.S. Application No.: 10/576,718

Attorney Docket No.: BWT06-04(Lein)

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**REMARKS**

In response to the Office Action mailed on August 4, 2009, Applicant(s) respectfully request(s) reconsideration.

Claims 1-3, 5-11, 13-14, 16-20, 24-31, 34, and 38-51 are now pending in this Application.

Claims 14 and 19, 34 and 38 been indicated as being in condition for allowance.

In this Amendment, claims 3 and 7 have been amended. Claims 1, 13, 20 and 34 are independent claims and the remaining claims are dependent claims.

Applicant(s) believe that the claim(s) as presented are in condition for allowance. A notice to this affect is respectfully requested.

**Specification:**

Applicant herein presents claims numbered as suggested by the Examiner in the Office Action at paragraph 1. Claim numbering reverted from the preliminary amendment of April 21, 2006 has been restored accordingly, and such claims are not denoted as having been "amended" in this Office Action from merely being renumbered to comply with the Examiner's indication.

**Election/Restriction:**

Further to the election requirement mandated by the Examiner, group II Claims 52 and 53 have been cancelled.

**Objections:**

Claim 7 has been amended to correct an antecedent issue.

**Rejections under 35 U.S.C. §112:**

The Office Action rejects claims 3 and 8 for indefiniteness. With respect to claim 3, Applicant submits that the claim wording is not that the analyte of interest is "either a naturally occurring or introduced substance", but "either a naturally

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occurring or an intentionally introduced substance" (emphasis added). It is respectfully submitted that, out of the possible types of substance which could serve as the analyte of interest, a naturally occurring substance and an intentionally introduced substance are not the only possibilities. For example, the analyte could be a substance which does not occur naturally but which has not been specifically introduced for the purpose of the scanning procedure, as disclosed in the specification at page 21, lines 1-13 (paragraph [0058] of the published US specification). Such an alternative analyte could be present in a subject who has taken drugs, whether legally or illegally, or who has been exposed to a particular chemical atmosphere. Claim 3 has been herein amended to recite at least one of a naturally occurring or an intentionally introduced substance. As such, the specific selection of "at least one of naturally occurring or an intentionally introduced substance" does provide a further limitation to the claim. It is therefore requested that the rejection under 35 U.S.C. §112 be withdrawn.

Claim 8 has been rejected as failing to further limit the claimed invention. It is submitted that claim 8 further specifies how the method of claim 1 operates by reciting the feature that the signal reaches a peak when the measurement location is coincident with an interface of the eye, as disclosed in the specification at page 5, lines 14-34 (para. [0015]) and at page 17, lines 10-21 (para. [0048]). Accordingly, claim 8 does provide a further limitation to the claimed invention and it is respectfully requested that the rejection under 35 U.S.C. §112 be withdrawn.

**Rejections under 35 U.S.C. §101:**

The Office Action rejects independent claims 1 and 20 and corresponding dependent claims as being nonstatutory. The rationale rejecting the claims is consistent with the recent In re Bilski machine or transformation test. To satisfy the machine-or-transformation test, the claim must either be tied to a particular machine or transform an article. First, the use of a specific machine or

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transformation of an article must impose meaningful limits on the claim's scope. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. With respect to the machine prong, the court goes on to clarify:

A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article.

Such a rejection requires that the claimed subject matter relate to abstract concepts, phenomena of nature or mental processes accomplished solely within one's mind. The claimed method, however, relates to and requires tangible physical measurements. Claims 1 and 20 require the use of some form of physical device ("machine") in order to perform the claimed method steps. How else could light be focused and scanned through the anterior chamber of the eye? How else could the reflected light be detected and converted into a signal from which apparent positions of interfaces of the eye may be derived? Claim 20 even specifies a light source (a physical device) and specifies several steps which require a physical device, such as spatially filtering light and measuring an intensity of reflected light. Therefore, claims 1 and 20 satisfy the machine or transformation test suggested by the Office Action. It is therefore requested that the rejection under 35 U.S.C. §112 be withdrawn.

**Double Patenting:**

In sections 10 and 11 of the Office Action, a provisional objection has been raised that a selection of the claims of this application are unpatentable in view of claim 6 of co-pending application number 10/582,648. This rejection is respectfully traversed, as the two applications do not claim the same subject matter, thus the Applicant is not attempting to improperly extend any "right to

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exclude" granted by a patent. The claims of the later application (USSN10/582,648) relate to the use of an optical element adapted to provide an extended focal region for monochromatic light - so that scanning a measurement location through the eye is not necessary - whereas the current application does involve scanning a measurement location through the eye. These techniques are very different in nature and it is not correct to allege that one would deprive the other of novelty or inventive step.

For the sake of completeness, step (a) of method claim 1 of USSN 10/582,648 requires, among other things, the focusing of a monochromatic incident beam of light by an optical element adapted to provide an extended focal region for monochromatic light, such that incident light is focused to all measurement locations along the measurement line concurrently. That is, all measurement locations along the measurement line receive focused light at the same time, through the use of the specially adapted optical element for providing an extended focal region for monochromatic light. In contrast, the claims of the present application require light to be focused to a measurement location and then for that measurement location to be scanned through the anterior chamber. That is, light is focused to a single measurement location which is then scanned through the eye.

Neither set of claims, from either application, is anticipated by or obvious over the other. As such, it is respectfully requested that the double-patenting objection be withdrawn.

As the remaining claims depend, either directly or indirectly, from claims 1, 13, 20 and 34, which by the foregoing remarks are deemed allowable, it is respectfully submitted that all claims are now in condition for allowance.

**Filing Status:**

Please note that Applicant has recently become aware that the small entity status claimed upon application filing may have been inappropriate.

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Accordingly, application herewith files payment for a shortfall of inadvertent small entity status claim. Please specify Applicant's filing status as "Non-Small Entity."

Applicant(s) hereby petition(s) for any extension of time which is required to maintain the pendency of this case. If there is a fee occasioned by this response, including an extension fee, that is not covered by an online payment made herewith, please charge any deficiency to Deposit Account No. 50-3735.

If the enclosed papers or fees are considered incomplete, the Patent Office is respectfully requested to contact the undersigned collect at (508) 616-9660, in Westborough, Massachusetts.

Respectfully submitted,



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Dated: November 4, 2009